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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,874	06/11/2002	Yasuo Tano	112372	4957

7590

08/18/2005

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EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,874

Applicant(s)

TANO, YASUO

Examiner

Sarah K. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Amended claims 9-15 and new claims 16 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims were dependent upon claim 1 and directed toward the holding apparatus. Claims 9-11 and 16 are now directed toward the holding portion only, which is a subcombination of the originally presented combination. Claims 12-15 and 17 are now directed toward the connecting portion only, which is a subcombination of the originally presented combination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,3,4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,171,254 (Sher) in view of US Patent No. 6,092,898 (de Juan, Jr.)

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Engaging portions (66) on the holder (61) connect with connection portions (24) on the eyelid openers and include holes (24) that are shown in Figure 2. The eyelid openers are biased apart by a spring (34). The holding portion and eyelid

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openers are connected in an adjustable manner, as they are removable from one another. Sher clearly states that the position of the ring (61) can be adjusted relative to the eyelid openers (column 3, lines 8-12). This also means that the ring is adjustable relative to the eyeball. Sher states that it's obvious to use various forms of connection means, such as hook and loop structure, between the holding portion (61) and eyelid openers (22) (column 3, lines 13-26).

Sher fails to state that the holding ring is connected to a surgical lens, although the structure is capable of performing this function. De Juan discloses a method of viewing the interior of an eye and teaches that it is known in the art to place a surgical lens (20) on the surface of the eye (column 1). De Juan teaches that the surgical lens can be held on or near the eye by a ring (10) or viewing device (30) (column 3, line 22-25 and column 7, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Sher device to hold a surgical lens, as de Juan teaches that various types of devices with a ring shaped portion can be used to position the lens relative to the eye during a surgical procedure so that the surgeon can view the interior of the eye. Since the Sher device would allow the lens to be releasably placed on the eye, the surgeon would not be required to hold a tool for this purpose.

Regarding claims 6 and 7: Sher fails to form the adjustable connection portions between the ring (61) and the eyelid openers (22) to include a closed loop of elastic silicone rubber. Sher teaches that any type of alternative equivalent mechanical attachment mechanism could be used to secure the ring (61) to the eyelid openers (column 7, lines 13-27). Sher even states that a hook and loop, or Velcro, mechanism could be used. Applicant has not specified that the rubber loop connection

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mechanism solves any particular problem or has any functional advantages over other attachment mechanisms known in the art. Therefore, it would be obvious to simply tie the ring to the eyelid openers with a loop of silicone rubber. It would be an obvious matter of design choice to replace the sophisticated connection bars (68,66) on the ring of Sher with a simple loop of rubber, as Sher teaches that any mechanical attachment mechanism is suitable for attaching the ring to the eyelid openers.

3. Claims 1,4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,556,417 (Sher) in view of US Patent No. 6,092,898 (de Juan, Jr.)

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Connecting portions (44,42,40) attach the ring (61) to the eyelid openers and an elastic member (36) is included in this connection means. Figures 2, and 2A show more clearly that the ring (61) is chamfered. Sher explains that the position between the ring (61) and eyelid openers (22) is adjustable (lines 30-37). This also means that the position of the ring relative to the eyeball is adjustable. Sher does include an adjustable mechanism in the form of a collar and set screw (26,32) for connecting the eyelid openers.

Sher fails to state that the holding ring is connected to a surgical lens, although the structure is capable of performing this function. De Juan discloses a method of viewing the interior of an eye and teaches that it is known in the art to place a surgical lens (20) on the surface of the eye (column 1). De Juan teaches that the surgical lens can be held on or near the eye by a ring (10) or viewing device (30) (column 3, line 22-25 and column 7, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Sher device to hold a surgical

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lens, as de Juan teaches that various types of devices with a ring shaped portion can be used to position the lens relative to the eye during a surgical procedure so that the surgeon can view the interior of the eye. Since the Sher device would allow the lens to be releasably placed on the eye, the surgeon would not be required to hold a tool for this purpose.

Response to Arguments

4. Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive. As explained above, Sher clearly states that the position of the holding ring is adjustable. The arguments directed toward holding the lens are considered to be moot in view of the new grounds of rejection. Arguments with respect to the new claims are moot since they are withdrawn in view of the election by original presentation.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

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of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K. Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW
8/13/05

SKW
Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER